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10/764,111	01/23/2004	Samuel P. Hopkins	4090.1006-000	7881
21005 7590 12/31/2009 HAMILTON, BROOK, SMITH & REYNOLDS, P.C. 530 VIRGINIA ROAD P.O. BOX 9133 CONCORD, MA 01742-9133				
EXAMINER NGUYEN, QUANG N				
ART UNIT		PAPER NUMBER		
2441				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/764,111

Applicant(s)

HOPKINS, SAMUEL P.

Examiner

QUANG N. NGUYEN

Art Unit

2441

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 September 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-21 and 41-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-21 and 41-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date See Continuation Sheet
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :06/08/2005, 07/25/2005, 09/19/2005, 05/27/2008, 06/16/2006 and 05/26/2009

Detailed Action

1. This Office Action is responsive to the Response to Election/Restriction filed on 09/25/2009. Claims 16-21 and 41-45 are elected for examination.

Information Disclosure Statement

2. The information disclosure statements (IDSes) submitted on 06/08/2005, 07/25/2005, 09/19/2005, 05/27/2008, 06/16/2006 and 05/26/2009 are in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statements are being considered by the examiner.

Claim Objections

3. Claims 17-20 and 42-45 are objected to because of the following informalities:

On line 1 of claims 17-20: "A method ..." is suggested to be "[[A]] **The** method ..."

On line 1 of claims 42-45: "A method as set forth in claim 7 ..." is suggested to be

"[[A]] **The** method as set forth in claim [[7]] **41** ..."

Appropriate correction is required.

4. Claims 17-20 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Since claims 17-20 recite the intended use of the claimed invention failing to further limit the subject matter of claim 16, Examiner respectfully submits that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. **Claims 16-21 and 41-45 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

7. Claims 16-21 and 41-45 are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. While the claims 16, 21 and 41 recite a series of steps or acts to be performed, a statutory "process" under 35 U.S.C. 101 must (1) be tied to particular machine, or (2) transform underlying subject matter (such as an article or material) to a different state or thing. See page 10 of *In Re Bilski* 88 USPQ2d

1385, 1391 (Fed Cir 2008). The instant claims are neither positively tied to a particular machine that accomplishes the claimed method steps nor transform underlying subject matter, and therefore do not qualify as a statutory process.

The method claims 16, 21 and 41 include steps of "interposing, requesting, recording, and incrementing" (*it appears that said recited nodes could be directed to human users rather than machines*) which are broad enough that the claim could be completely performed mentally, verbally or without a machine nor any transformation apparent.

Thus, method claims 16-21 and 41-45 are non-statutory since they are not requisitely tied to another statutory class (such as tied to a particular machine that accomplishes the steps) and they do not requisitely transform underlying subject matter to a different state or thing.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 16-21 and 41-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bauer et al. (US 7,600,033), hereinafter "Bauer", in view of

Lindemann et al. ("A Distributed Search Service for Peer-to-Peer File Sharing in Mobile Applications" submitted as an IDS filed 05/26/2009), hereinafter "**Lindemann**".

10. As to claim 16, **Bauer** teaches a method for advertising on a peer to peer network having at least two nodes, said method comprising:

interposing at least one node pseudonode on said network (*a network traffic control unit 5 comprises a filter unit 51 intercepting messages related to peer to peer application from a network line*) (**Bauer, Figs. 4 and 6, Abstract and col. 9, line 59 – col. 10, line 10**);

monitoring said network through at least one pseudonode to detect requests (*a network traffic control unit 5 comprises a filter unit 51 monitoring the network line 3 and filtering all messages related to peer to peer applications*) (**Bauer, Figs. 4 and 6, Abstract and col. 9, line 59 – col. 10, line 10**).

Bauer does not explicitly teach requesting a specific node upload a file index number starting at N, where N is a real number, to said pseudonode; recording said specific file name is sent; and incrementing the file index number and repeating the request until such time as the specific node no longer responds.

In the same field of endeavor, **Lindemann** teaches a Passive Distributed Indexing "PDI", a general-purpose distributed search service for document exchange in mobile applications, which is based on peer-to-peer technology, wherein each mobile device implementing PDI maintains a local index cache which is a data structure that

stores pairs of keywords and document identifiers for documents matching these keywords. PDI defines a mechanism to fill the index cache with pairs of keywords and document identifiers for documents located at remote devices (*i.e.*, *requesting a specific node upload a file index number starting at N, where N is a real number, to said pseudonode; recording said specific file name is sent; and incrementing the file index number and repeating the request until such time as the specific node no longer responds*) (**Lindemann, “3. Passive Distributed Indexing”, pages 3-4**).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the feature of filling the index cache with pairs of keywords and document identifiers for documents located at remote devices, as disclosed by **Lindemann**, into the teachings of **Bauer**. One would be motivated to do so to allow the index cache to be used by a mobile device to generate answers for queries, even if it does not store any matching document (**Lindemann, “3. Passive Distributed Indexing”, page 3**).

11. As to claims 17-20, claims 17-20 recite the intended use of the claimed invention, Examiner respectfully submits that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Therefore, claims 17-20 are rejected under the same rationale as claim 16.

12. Claims 21 and 41 contain similar limitations as claim 16; therefore, it is rejected under the same rationale.

13. As to claims 42-45, **Bauer-Lindemann** teaches the method of claim 41, wherein said list is generated by recording the client identification of nodes (*document identifier stored in the index cache includes a unique pair of path and device identifier*), who respond to the pseudonode when the pseudonode sends a specific search request, or whose responses match a certain term (*Lindemann teaches a Passive Distributed Indexing "PDI", a general-purpose distributed search service for document exchange in mobile applications, which is based on peer-to-peer technology, wherein each mobile device implementing PDI maintains a local index cache which is a data structure that stores pairs of keywords and document identifiers for documents matching these keywords. PDI defines a mechanism to fill the index cache with pairs of keywords and document identifiers for documents located at remote devices, "3. Passive Distributed Indexing", pages 3-4).*

14. Further references of interest are cited on Form PTO-892, which is an attachment to this Office Action.

15. A shortened statutory period for reply to this action is set to expire THREE (3) months from the mailing date of this communication. See 37 CFR 1.134.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quang N. Nguyen whose telephone number is (571) 272-3886.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's SPE, Wing Chan, can be reached at (571) 272-7493. The fax phone number for the organization is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Quang N. Nguyen/
Primary Examiner, Art Unit 2441